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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

STRODER, CARRIE A

ART UNIT

PAPER NUMBER

4154

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,692	Applicant(s) RABBAT, GUY	
	Examiner CARRIE A. STRODER	Art Unit 4154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 09 April 2004, wherein:

Claims 1-23 are currently pending.

Specification

1. **Claims 4 and 19 are objected** to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. For example, claim 4 is dependent on claim 1, which is directed to an "entity". However, the entity is not limited by the claim language "customers/shareholders receive tax deductible benefits." Further, applicant is attempting to remove a limitation of claim 1.

Claim Objections

1. **Claims 15 and 19 are objected** to because of the following informalities: "warrants" should be "warranties". Appropriate correction is required.

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Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-15 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 twice recites "a means for..." but does not provide a corresponding structure in the specification.

3. Claim 9, Applicant discloses a "system" with the attempt to define this system by the tasks performed by the processor. For example, "an entity" and "at least one customer/shareholder" are noted but not defined as a structure within the system. As a result, it appears Applicant is trying to claim the system by steps rather than the structure of the system. The Examiner notes that there is no structure claimed.

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Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-8 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For example, claim 1 is directed to an "entity". An entity is neither a process, a machine, a manufacture, nor a composition of matter. Therefore, it is non-statutory subject matter.

3. **Claims 9-15 are rejected** under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a system (ex. preamble of claim 9), and subsequently the claim deals with the specifics of a method (the steps) executed by the "system"; however, there is no structure given for the system. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set

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forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

4. **Claims 16-23 are rejected** under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 16-23, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. **Claims 1-3 and 5-23 are rejected** under 35 U.S.C. 102(b) as being anticipated by "Logistix Acquires IBM Subsidiary in Mexico; Acquisition of Adatsa Expands Outsourced Software and Hardware Manufacturing Capabilities in Mexican Market," 02 August 1999 (hereinafter referred to as "Logistix").

Referring to claim 1:

Logistix teaches an entity for supporting a collaborative shared services business system, the entity comprising:

a for-profit corporation having one or more managers to manage the entity (Section I; inherent, as all corporations have one or more managers),

a means for performing one or more collaborative services as needed for the customers/shareholders (Section I; inherent, as all corporations provide a service as needed); and

a means for distributing at least part of its earnings to each of its customers/shareholders (Section I; as all corporations have a means for distributing earnings);

wherein the entity is organized to allow the sale of shares of the entity to one or more customers/shareholders (Section I; inherent, as all corporations have this ability);

accept the transfer of assets from the customers/shareholders (Section I; inherent, as all corporations have this ability);

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receive special tax treatment (Section I; inherent, as all corporations receive special tax treatment); and

wherein the entity charges a fee for the collaborative shared services it provides to each customer/shareholder on a per transaction basis or based on the services provided during a specified period of time (Section I; inherent as all for-profit corporations must charge a fee either on a per transaction basis or services provided during a certain time in order to make money).

Referring to claim 2:

Claim 2 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein.

Logistix teaches further comprising a means for outsourcing all or a portion of the entity's collaborative shared services to an unrelated supplier (Section I).

Referring to claims 3 and 18:

Claim 3 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Claim 18 is dependent on claim 16; therefore the rejection of claim 16 is incorporated herein.

Logistix teaches wherein the means for distributing earnings is through dividends to the shareholders and the special tax treatment allows for the entity to take a tax

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deduction for the dividends allocated to the shareholders
(Section I; inherent).

Referring to claims 5, 12, and 20:

Claim 5 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Claim 12 is dependent on claim 9; therefore the rejection of claim 9 is incorporated herein. Claim 20 is dependent on claim 16; therefore the rejection of claim 16 is incorporated herein.

Logistix teaches further comprising at least one sub-entity under the direction of the entity, said sub-entity specializing in a particular collaborative shared service (Section I and III; Adatsa is a sub-entity of IBM).

Referring to claims 6, 11, and 21:

Claim 6 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Claim 11 is dependent on claim 9; therefore the rejection of claim 9 is incorporated herein. Claim 21 is dependent on claim 16; therefore the rejection of claim 16 is incorporated herein.

Logistix teaches further comprising one or more remote entities, said remote entities being geographically separate from each other (Section I; Adatsa, located in Mexico, is geographically remote from IBM).

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Referring to claims 7 and 21:

Claim 7 is dependent on claim 6; therefore the rejection of claim 6 is incorporated herein. Claim 21 is dependent on claim 16; therefore the rejection of claim 16 is incorporated herein.

Logistix teaches wherein each of the remote entities has a regional manager for managing each of the remote entities (Section I; inherent, as remote companies must have local management to oversee the operations of the company).

Referring to claims 8 and 23:

Claim 8 is dependent on claim 6; therefore the rejection of claim 6 is incorporated herein. Claim 23 is dependent on claim 16; therefore the rejection of claim 16 is incorporated herein.

Logistix teaches wherein ownership of the customers/ shareholders belonging to one remote entity is not necessarily the same as the ownership of the customers/ shareholders belonging to another remote entity (Section I; inherent as IBM and Adatsa were both public companies and therefore did not necessarily have the same ownership).

Referring to claim 9:

Logistix teaches a collaborative shared services business system comprising:

a. an entity (Section I);

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b. at least one customer/shareholder (Section I and II; inherent);

c. an assets transfer from a given customer/shareholder to the entity (Section I; IBM transferred Adatsa, its asset, to Logistix);

d. a management scheme for the entity to manage the assets and provide one or more needed collaborative shared services to the customer/shareholder (Section I; inherent);

wherein the entity is a for-profit corporation and charges a fee for the collaborative shared services it provides to each customer/shareholder on a per transaction basis or based on the services provided during a specified period of time (Section I; inherent).

Referring to claims 10 and 17:

Claim 10 is dependent on claim 9; therefore the rejection of claim 9 is incorporated herein. Claim 17 is dependent on claim 16; therefore the rejection of claim 16 is incorporated herein.

Logistix teaches further comprising an outsourcing mechanism to outsource all or a portion of the entity's collaborative shared services to an unrelated supplier (Section I).

Referring to claim 13:

Claim 13 is dependent on claim 9; therefore the rejection of claim 9 is incorporated herein.

Logistix teaches wherein the entity distributes at least some of its profits to each customer/shareholder through dividends or in a form of deductible benefits (Section I; inherent).

Referring to claim 14:

Claim 14 is dependent on claim 13; therefore the rejection of claim 13 is incorporated herein.

Logistix teaches wherein the entity is entitled to special tax treatment that allows for the entity to take a tax deduction for the dividends allocated to the shareholders (Section I; inherent).

Referring to claim 15:

Claim 15 is dependent on claim 13; therefore the rejection of claim 13 is incorporated herein.

Logistix teaches wherein the deductible benefits comprise volume discounts, rebates and warranties (Section I; inherent).

Referring to claim 16:

Logistix teaches a method for operating a collaborative shared services business system comprising:

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a. establishing an entity, said entity being a for-profit corporation, and having one or more managers to manage the entity (Section I; inherent);

b. purchasing a portion of the entity through a purchase of shares of stock by one or more customers/shareholders (Section I; inherent);

c. transferring assets from each customer/shareholder to the entity (Section I; IBM transferred Adatsa, its asset, to Logistix);

d. providing needed collaborative shared services to each customer/shareholder (Section I; inherent);

e. distributing at least a portion of its profits to its shareholders, which include the customers/shareholders (Section I; inherent);

f. charging a fee for the collaborative shared services the entity provides to each customer/shareholder on a per transaction basis or based on the services provided during a specified period of time (Section I; inherent);

wherein the entity receive special tax treatment (Section I; inherent).

Referring to claim 19:

Claim 19 is dependent on claim 16; therefore the rejection of claim 16 is incorporated herein.

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Logistix teaches wherein the entity does not receive special tax treatment and the distributing at least a portion of its profits to its shareholders is provided through volume discounts, rebates and warranties to the customers/shareholders (Section I; inherent).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 4 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Logistix in view of "C Corporations Versus S Corporations" (hereinafter referred to as "Corporations").

Referring to claim 4:

Claim 4 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein.

Logistix does not explicitly teach; however Corporations does teach wherein the entity does not receive special tax

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treatment but customers/shareholders receive tax deductible benefits (Section I).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Logistix and Corporations as a whole to produce the invention as claimed with a reasonable expectation of saving money for customers/shareholders and therefore making the corporation a more attractive investment to them.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 7:00 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571)272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 4154

/Vu Le/
Supervisory Patent Examiner,
Art Unit 4154